

REMARKS

Claims 1-37 have been canceled. Claims 38-81 are active in the present application.

Claim Amendments

Claim 39 and 40 have been amended to describe the aqueous and non-aqueous matter in terms of the word “composition” than “aqueous.” It is clear from the language in the specification and claims in general that the term “solution” is not appropriate. Rather, such terms as composition, dispersion or suspensions are appropriate. Accordingly, appropriate amendment to each of these claims is necessary for the sake of accuracy.

As to Claims 78 and 79, awkwardness in each claim has been eliminated by the amendments that have been made. Thus, the amendments to the claims do not introduce new matter into the case. Entry of the amendments is respectfully requested.

Restriction Requirement

Restriction has been required in the form of the election of a designated invention from Groups I to III. In reply to the requirement applicants hereby elect Claims 38-51, 55-71 and 81 of Group I for examination with traverse.

In traversing the requirement, applicants do not concur that the Examiner has demonstrated a distinction between Groups I and II on the record. In the first place, a more proper basis for making the restriction between the claims of Groups I and II is not MPEP 806.05(f), but rather 806.05(h). Claim 38 is directed to a composite compound product, while Claim 52 is directed to a method of making various products where the products are prepared

from the composite compound of Claim 38. Thus, on the record the Examiner has not demonstrated how the composite compound of Claim 38 can be used to prepare various products other than by the method claimed, and has not demonstrated how the method of Claim 52 can be practiced with a material other than the composite compound of Claim 38. Accordingly, one way distinction has not been shown and withdrawal of this aspect of the requirement is respectfully requested.

As to the matter of a distinction between Claims 38-51, 55-71 and 81 of Group I and Claims 72-74 of Group III, and the distinction between Claims 52-54 of Group II and Claims 72-74 of Group III, the Examiner has not shown how the compared sets of claims are clearly distinct from each other. With respect to the issue of Groups I and III, it is noted that the uncoated filling composition of Claim 71 requires the composite compound of Claim 38 and that the sheet of base paper to be coated of Claim 72 requires the uncoated filling composition of Claim 71. How has separate and distinct inventions been demonstrated on the record in view of the guiding commentary of MPEP 806.04?

As to the alleged distinction between Claims 52-54 of Group II and Claims 72-74 of Group III, the sheet of base paper to be coated of Claim 72 is dependent on the uncoated filling composition of Claim 71 that contains the composite compound of Claim 38, while the method of manufacture of suspensions, paper coating colors, paper filing and paper surface treating of Claim 52 requires the composite compound of Claim 38. In view of this interrelationship, in the sense of demonstrating separate and distinct invention of MPEP 806.04, it is not clear how the Examiner has demonstrated patentable distinction between the designated groups of invention. Accordingly, it is believed that a firm basis of separate and

Appln No. 10/827,531
Reply to Restriction Requirement

distinct invention has been demonstrated by the Examiner and withdrawal of the restriction requirement is respectfully requested.

As to the election of species requirement, applicants hereby elect the aqueous composition of Claim 39 and further elect a paper coating color. The election is made with traverse.

In making the election of species, applicants do so with the expectation that the elected species will provide a basis for the Examiner to start his search of relevant prior art and that in the event relevant prior art is not developed with respect to the elected species, that the search for relevant prior will be expanded to include the other designated species.

It is now believed that the application is in proper condition for examination.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

A handwritten signature in black ink, appearing to read "F D Vastine", with a long horizontal flourish extending to the right.

Frederick D. Vastine, Ph.D.
Registration No. 27,013

Customer Number
22850

(703) 413-3000
Fax #: (703) 413-2220
NFO/FDV